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## *punchbowl, inc. v. aj press: a trademark defendant prevails post-jack daniel's*

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*Punchbowl, Inc. v. AJ Press* is one of the first rulings to grapple with an infringement case following the U.S. Supreme Court's recent limitation of the applicability of a First Amendment-based defense in *Jack Daniel's Properties v. VIP Products LLC*. The opinion, issued in the case last week upon remand after the Ninth Circuit's reading of *Jack Daniel's*, not only held in favor of the defendant upon a likelihood-of-confusion analysis, but also found against the plaintiff on nearly every factor.

Until last year, courts historically held plaintiffs in trademark infringement suits to a higher standard where the alleged infringement involved an expressive work. More generally, many courts, including the Second and Ninth Circuits, found no liability for trademark infringement where a defendant's work was expressive unless the defendant's use of the allegedly infringing mark had no artistic relevance to the underlying work whatsoever, or, if it had some artistic relevance, unless the title was explicitly misleading as to the source or the content of the work.

This rule was derived from the Second Circuit's holding in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). In June 2023, the U.S. Supreme Court narrowed the applicability of *Rogers*, holding in *Jack Daniel's Properties v. VIP Products LLC*, 599 U.S. 140 (2023) that *Rogers* does not apply where a defendant uses its mark to identify its products.

The *Rogers* test emerged from the notion that trademark law's traditional likelihood-of-confusion test fails to accord due weight to the public's interest in free expression. However, in *Jack Daniel's*, the Supreme Court held that *Rogers* does not apply when a defendant uses a trademark "in the way the Lanham Act most cares about: as a designation of source for the infringer's own goods." Therefore, while, for example, the use of the Barbie name in the song "Barbie Girl" should be protected from liability under *Rogers*, as the name is not used as a source identifier, a dog toy designed to look like a bottle of Jack Daniel's

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whiskey and using the trademark "Bad Spaniels" as a source identifier should not be so protected.

### **The Impact of the Supreme Court's Holding in Jack Daniel's on Punchbowl v. AJ Press**

*Punchbowl, Inc. v. AJ Press*, No. 2:21-cv-03010-SVW-MAR (C.D. Cal. Aug. 22, 2024) is a case that was directly impacted by the Supreme Court's holding in *Jack Daniel's*. The plaintiff, Punchbowl, is a company that develops online invitations and greeting cards. The defendant, AJ Press, operates a publication called Punchbowl News, which provides newsletters, podcasts, and videos in the fields of government and current events. In 2021, Judge Steven Wilson of the Central District of California granted AJ Press's motion for summary judgment, applying the *Rogers* test and concluding AJ Press was not liable because the name "PUNCHBOWL" constituted protected expression and was not explicitly misleading as to its source. In November 2022, the Ninth Circuit affirmed. A week later, the Supreme Court granted certiorari in *Jack Daniel's*.

The Ninth Circuit then reconsidered its earlier decision and reversed and remanded, holding that *Rogers* did not apply because AJ Press used its mark to designate the source of its own goods. Quoting *Jack Daniel's*, the Ninth Circuit noted that, although the mark had expressive qualities, the fact that AJ Press "used a trademark as a trademark" prevented it from relying on *Rogers*. The Court remanded to the district court for consideration of the issue under the traditional test for trademark infringement under *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979).

### **The Decision on Remand**

Last week, upon remand, Judge Wilson granted AJ Press's motion for summary judgment. Conducting a likelihood-of-confusion analysis, the court discussed each of the *Sleekcraft* factors, and came to the following conclusions:

**Strength or Weakness of Punchbowl's Mark:** The court held that Punchbowl's mark was only entitled to weak protection as there was no evidence showing that Punchbowl's efforts to strengthen its mark had borne fruit or that consumers considered the mark to be particularly strong.

**Proximity of the Goods:** The court held that no reasonable jury could find that the goods offered by the parties were proximate, given that: (1) their goods were neither complementary nor similar in use and function, given that a platform offering tools for online party planning is "not at all related" to a news publication focusing on government affairs; (2) their products are sold to different demographics of purchasers; and (3) their ventures operate in different spaces.

**Similarity of the Marks:** The court held that while the parties' marks were identical when shortened simply to "PUNCHBOWL," the marks were displayed in visually distinct ways and were different when spelled out in full, and therefore any similarities only "slightly" favored Punchbowl.

**Actual Confusion:** The court held that Punchbowl had offered no valid evidence of actual confusion, and that while there was some evidence of customers contacting Punchbowl and/or Punchbowl News, believing that they were the same or affiliated, such instances were not legally significant as they were easily remedied by a



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clarifying reply, and the number of such instances was small.

**Marketing Channels:** The court held that there was no evidence of anything more than a superficial overlap in the marketing channels used by the parties, noting that while the parties appeared to use the same and overlapping online channels, such as Google, Facebook, and Instagram, any marketing in the modern economy would involve such use.

**Consumer's Degree of Care:** The court noted that it was not convinced that it was worth analyzing the type of goods and the degree of care likely to be exercised by the purchaser, given the disparate nature of the services offered by the parties, but noted for the sake of completeness that consumers should be prompted to check what they are signing up for when subscribing to each party's services, given that the services were moderately priced and subscription-based.

**Defendant's Intent:** The court gave neutral weight to the issue of AJ Press's intent, since, although the evidence in the record overwhelmingly supported AJ Press's claim that the name "Punchbowl News" was chosen to evoke the U.S. Capitol building, no such intent is necessary to demonstrate a likelihood of confusion.

**Future Expansion:** The court also gave neutral weight to the issue of any likelihood of future expansion, noting that the implication that Punchbowl News' live events might be a stepping stone to subscriptions similar to the plaintiff's, such as customizable event invitations, was not credible.

When weighing the *Sleekcraft* factors, the court held that, ultimately, the dissimilarity and lack of proximity between the services provided by the parties entitled AJ Press to summary judgment on Punchbowl's trademark infringement claims, and noted that no reasonable consumer would, due to confusion, purchase a subscription to a party planning software platform when they intended to subscribe to a news website (or vice versa).

The court's analysis in *Punchbowl v. AJ Press* is interesting, in that a defendant who had prevailed under the *Rogers* test also prevailed under the traditional *Sleekcraft* test—but only did so after, undoubtedly, a significant expenditure of attorney's fees and costs in discovery. Future rulings may help to signal and define the extent of impact, as well as the practical impacts, of *Jack Daniel's* on trademark cases.